

Application No.: 09/963,311  
Amendment Dated: March 13, 2006  
Reply to Office Action of: December 12, 2005

MAT-8187US

**Remarks/Arguments:**

Claims 1-16 are pending in the application. Claims 1-16 stand rejected. By this Amendment, claims 1, 4, 5, 7, 8, 10, 11, and 13-16 are amended.

**Introduction**

Applicant's invention relates to an Internet telephone system. The Internet telephone system includes at the calling end a telephone set connected to a first modem which is connected through the Internet to a server. At the receiving end, there is a second telephone set connected to a second modem which is also connected through the Internet to the server. During the placing of a call, the first telephone set receives the telephone number of the second telephone set. (See page 6, lines 8-9). The first modem then acquires from the server the public IP address corresponding to the telephone number of the second telephone set. (See page 6, lines 9-12). The first modem then initiates the connection. (See page 6, lines 12-14).

**Rejections under §102(e)**

Claims 1, 2, 7, 8, and 13-16 are rejected under 35 U.S.C. § 102(e) as being anticipated by Borella et al. (U.S. Patent No. 6,731,642) ("Borella"). It is respectfully submitted, however, that the claims are patentable over the art of record for the reasons set forth below.

The Office Action on page 3, lines 3-9, and page 7, lines 2-14, focuses on the disclosure by Borella at column 7, line 65 - column 10, line 18, which relates to the procedure for setting up a telephone call from caller station 24 to callee station 26 in communication system 10. (See col. 7, lines 65-67). Accordingly, this Response provides a detailed summary of the intricate and precise procedure by which a call is

placed from caller station 24 to callee station 26 in Borella. From this summary below, it is apparent that Borella does not disclose all of the features of claim 1.

In Borella, when caller station 24 receives the telephone number of callee station 26, first gatekeeper 30 transmits a lookup message to server 34, which lookup message contains the callee station number. (See col. 8, lines 16-21). Server 34 receives the lookup message and the callee station number, searches its database using the callee station number, and transmits **back to first gatekeeper 30** the **public second gatekeeper address**. (See col. 8, lines 21-27).

After receiving the response from server 34, first gatekeeper 30 communicates with first router 18 to establish a **proxy** public caller address for the **private** caller address. (See col. 8, lines 28-38). First gatekeeper 30 then transmits a gatekeeper setup message over intermediate network 12 to second gatekeeper 32, which gatekeeper setup message includes the callee station number and the proxy public caller address. (See col. 8, lines 45-52). In response, second gatekeeper 32 transmits a lookup message to server 34 using the callee station number. (See col. 8, lines 53-59). Server 34 responds to second gatekeeper 32 with a message that includes the **private** callee address. (See col. 8, lines 63-64). Using the response from server 34, second gatekeeper 32 communicates with second router 20 to establish a **proxy** public callee address for the **private** callee address. (See col. 8, line 59 - col. 9, line 6). Additionally, second gatekeeper 32 communicates with second router 20 to establish a proxy private caller address which serves to identify caller station 24 on second edge network 16. (See col. 9, lines 13-23).

**Second router 20** then sends a ring message over second edge network 16 to second telephony interface 28. (See col. 9, lines 23-28). **Second router 20** also

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sends an "originating ringing message" to first router 30, which message lists **as its destination address the "proxy public caller address."** (See col. 9, lines 33-35).

#### **Claim 1 - First Distinguishing Features**

Applicant's invention, as recited by amended claim 1, includes first features which are neither disclosed nor suggested by Borella et al., namely:

said first modem acquires a **public IP address** corresponding to a telephone number of the second telephone set **from the server**. (emphasis added)

The above-quoted portion of claim 1 recites that a first modem (which is coupled to a first telephone set) acquires **a public IP address from a server**, the public IP address corresponding to a telephone number of the second telephone set. These features are found in the originally filed application at page 5, line 18 - page 6, line 14. According to Applicant, it is understood in the art that the IP address assigned by an Internet service provider, as disclosed in the specification, is a public IP address. No new matter has been added.

As described above, Borella discloses that in response to a first lookup request, server 34 responds "by transmitting a first lookup response message **back to first gatekeeper 30** (step 86)." (See col. 8, lines 23-25) (emphasis added). "The first lookup **response** contains the **public second gatekeeper address**." (See col. 8, lines 25-27) (emphasis added). Therefore, this first lookup response does not disclose "said first modem acquires a public IP address . . . from the server," as recited by Applicant's amended claim 1 because:

- The **public second gatekeeper address** in Borella is not "a public IP address corresponding to a telephone number

of the second telephone set." **It is an address corresponding to the public second gatekeeper.**

- The receipt by first gatekeeper of the public second gatekeeper address does not disclose that "said first modem acquires a public IP address . . . from the server." The response goes to the first gatekeeper, **not to a modem.**

Thus, Applicant respectfully disagrees with the arguments in paragraph 17(A) for the reasons discussed in this section.

### **Claim 1 - Second Distinguishing Features**

Applicant's invention, as recited by amended claim 1, includes second features which are neither disclosed nor suggested by Borella et al., namely:

"said first modem . . . **using the acquired public IP address** transmits a connection request **to said second modem**"

The above-quoted portion of claim 1 recites that the first modem acquires the public IP address that corresponds to the telephone number of the second telephone set. The first modem then uses this acquired public IP address to transmit a connection request to the second modem. These features are found in the originally filed application at page 6, lines 9-14. No new matter has been added.

As described above, Borella discloses that in communication system 10, first router 18 **acquires a private caller address** from first gatekeeper 30 and allocates a proxy public caller address **to itself**. (See col. 8, lines 29-36, FIG. 3, step 88). First router 18 transmits the proxy public caller address to second router 20 through gatekeepers 30 and 32. (See col. 8, line 38 - col. 9, line 18, FIG. 3, steps 90-102). When second router 20 receives the proxy public caller address, **second router 20 transmits a connection message to first router 18**. (See col. 9, lines 62-67,

FIG. 3, step 112). Therefore, this connection message does not disclose "said first modem . . . using the acquired public IP address transmits a connection request to said second modem," as recited by Applicant's amended claim 1 because:

- In Borella, the second router which transmits the connection message is on the receiving side of communications system 10. In Applicant's claim 1, the "first modem" which transmits the connection request and **is on the calling side of the claimed Internet telephone system**. It is incorrect to say that the receiving-side second router in Borella discloses a calling-side first modem.
- In Borella, the connection request made by the second router is not made "using the acquired public IP address." The proxy public caller address used by the second router in making its connect request is not a **public IP address corresponding to a telephone number of the second telephone set. It is a proxy address of router 15.**

#### **Response to Arguments of Paragraph 17**

Paragraph 17 of the Office Action asserts that Borella et al. teach "a first modem acquiring an IP address corresponding to a telephone number of the second telephone set from the server." More specifically, the Office Action contends:

Borella teaches that a call station 24 attempting to place a call to call station 26 needs to determine the address of call station 26. This is done by transmitting a lookup message that is sent to server 34, which has a relational database that relates station numbers to their respective network addresses. When the server receive[s] the lookup message, it looks up the callee station number in its database. (citing col. 6, line 60 - col. 8, line 64).

Applicant respectfully contends that this argument does not demonstrate that Borella et al. disclose that "said first modem acquires a public IP address . . . from the server," as recited by amended claim 1. As discussed above, in Borella, although the server receives the lookup message (See col. 8, lines 16-21), looks up the callee

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station number in its database (See col. 8, lines 21-23), and responds with the public second gatekeeper address (See col. 8, lines 25-27), **this lookup does not disclose that caller station 24 receives from server 34 a public IP address corresponding to callee station 26. Instead, it discloses that the server provides the public second gatekeeper address.**

Additionally, Paragraph 17 of the Office Action asserts that Borella et al. teach "the use of an IP address to transmit a connection request to the second modem." More specifically, the Office Action contends:

Borella teaches that a caller station acquires the IP address of the callee station by sending a lookup message to a server that has a relational database. The server looks-up the address corresponding to the callee's station number and replies with the callee stations' address. Using the acquired address, the connection can be made by sending a ringing message to the callee station, which provides an indication that a call has been directed to the callee station (connection request).

Applicant respectfully contends that the Office Action misreads Borella. As described in detail above, the server does not reply with the callee stations' address. Instead, the server replies with the public second gatekeeper address. Further, the ringing message sent to the callee station is sent by second router 20 which is on the receiving side not the sending side. (See col. 9, lines 22-28). This ringing message is not a connection request.

### **Summary of Differences**

According to Borella et al, first router 18 acquires a private caller address from first gatekeeper 30 and allocates a proxy public caller address to itself. (See FIG. 3, step 88, col. 8, lines 29-36). First router 18 transmits the proxy public caller address to second router 20 through gatekeepers 30 and 32. (See FIG. 3, steps 90-

102, col. 8, line 39 - col. 9, line 18). When second router 20 receives the proxy public caller address, second router 20 transmits a connect message to first router 18. (See FIG. 3, step 112, col. 9, lines 57-64).

Because a public IP address is used as a destination address in the Internet, if a modem (router) acquires the public IP address of another modem (router), the connection between these modems can be executed from the side with the modem that acquired the public IP address. In Borella, because first router 18 does not acquire the public IP address of second router 20, first router 18 does needs to inform second router 20 through gatekeepers 30 and 32 of the public IP address of first router 18 so that second router 20 may connect to first router 18. As a result, the connection between routers 18 and 20 is executed from the callee side (second router 20).

On the other hand, claim 1 of the present invention recites the following. Because a first modem (corresponding to first router 18) acquires a public IP address of a second modem (corresponding to second router 2) from a server, the first modem can directly transmit a connection request to the second modem without the use of the gatekeepers required in Borella. Because the first modem acquires the public IP address of the callee side (the second modem), the connection between modems is executed from the caller side (the first modem). This feature is not disclosed by Borella et al. The present invention has the advantage of using fewer pieces of equipment than the system disclosed by Borella et al.

Thus, claim 1 is patentable over Borella et al. for the reasons set forth above. Claims 2 and 7 include all of the features of claim 1 from which they depend. Thus,

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claims 2 and 7 are also patentable over the art of record for the reasons set forth above.

Independent claims 8, 14, and 16, which although not identical to claim 1, include features similar to claim 1. Claim 13, which depends from claim 8, and claim 15, which depends from claim 14, include all of the features of the claims from which they depend. Thus, claims 8, and 13-16 are also patentable over the art of record for the reasons set forth above.

**Rejections under §103(a)**

Claims 3-5 and 9-11 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Thornton et al. (U.S. Patent No. 6,363,065). Applicant incorporates by reference the arguments he made regarding the rejections of these claims in his March 11, 2005 response. For those reasons, dependent claims 3-5 and 9-11 are not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Thornton et al.

Claims 6 and 12 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Moon (U.S. Patent No. 5,864,758). Applicant incorporates by reference the arguments he made regarding the rejections of these claims in his March 11, 2005 response. For those reasons, dependent claims 6 and 12 are not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Borella in view of Moon.



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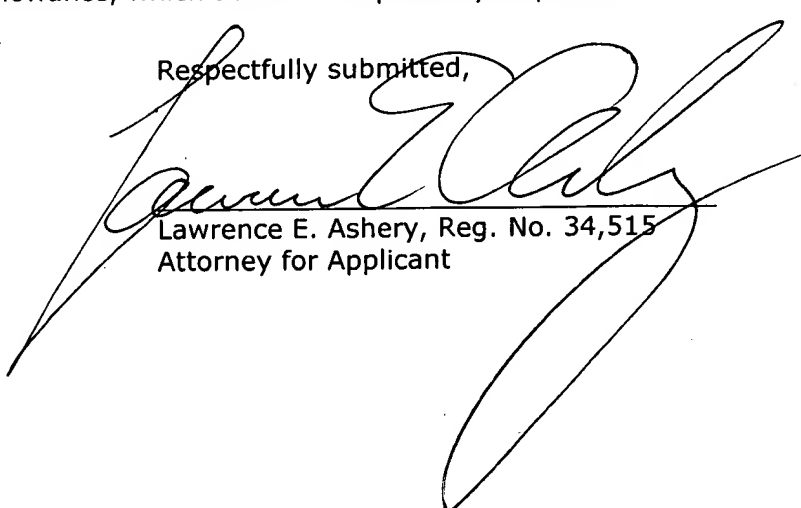


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**Conclusion**

In view of the amendments and arguments set forth above, the above-identified application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,

  
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